

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 3/11/03 APPL. S.N.: 09/946,153
EXAMINER: _____ ART UNIT: 1711
PARALEGAL: JEAN PROCTOR MAILROOM DATE: 3/5/03
AFTER FINAL: YES _____ NO ☒ NUMBER OF T.D.(S) FILED: 1

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

☒ The T. D. is PROPER and has been recorded. (See 14.23)

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)

☐ Application Examiner has not processed fee for T. D.

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)

☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)

☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)

☐ is not recognized as an officer of the assignee. (See 14.29.1)

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)

☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)

☐ The T. D. is not signed (See 14.26 and 14.26.3)


☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)

☐ Other _____

Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent			Docket N . DC4945
In Re Application Of: Bahadur, t. al.			
Serial No. 09/940,153	Filing Date August 27, 2001	Examiner S. McClendon	Group Art Unit 1711
Invention: Radiation Curable Compositions Containing Alkenyl Ether Functional Polyisobutylenes			
Owner of Record: Dow Corning Corporation			
<u>TO THE ASSISTANT COMMISSIONER FOR PATENTS:</u>			
<p>The above-identified owner of record of a 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,095,185. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors and/or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input checked="" type="checkbox"/> The undersigned is an attorney of record.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 20px;"> <div style="width: 45%;"> <p style="text-align: center;"><i>Larry A. Milco</i> _____ Signature</p> <p style="text-align: center;">Larry A. Milco _____ Typed or Printed Name</p> </div> <div style="width: 45%;"> <p>Dated: March 5, 2003</p> <div style="text-align: center;">  00137 <small>PATENT TRADEMARK OFFICE</small> </div> </div> </div> <div style="margin-top: 10px;"> <input type="checkbox"/> Terminal disclaimer fee under 37 C.F.R. 1.20(d) included. <input type="checkbox"/> PTO suggested wording for terminal disclaimer was unchanged. <input type="checkbox"/> Certification under 37 C.F.R. 3.73(b) is required if terminal disclaimer is signed by the assignee. </div>			

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CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)

Applicant(s): **Bahadur, et. al.**

Docket No.

DC4946

Serial No.

09/940,153

Filing Date

August 27, 2001

Examiner

S. McClendon

Group Art Unit

1711

Invention: **Radiation Curable Compositions Containing Alkenyl Ether Functional Polyisobutylenes**

I hereby certify that this Response to Rejection and Terminal Disclaimer

(Identify type of correspondence)

is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. 703-872-9310)

on March 5, 2003

(Date)

Christine M. Fitak

(Typed or Printed Name of Person Signing Certificate)

Christine M. Fitak

(Signature)

Note: Each paper must have its own certificate of mailing.

**RECEIVED
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GROUP 1700**

P18/REV01